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09/515,717	02/29/2000	Binh T. Nguyen	IGT1P030/P-282	1099

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EXAMINER

SAGER, MARK ALAN

ART UNIT

PAPER NUMBER

3714

DATE MAILED: 04/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/515,717

Applicant(s)  
Nguyen

Examiner  
Sager

Art Unit  
3714



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Nov 29, 2001 and Jan 18, 2002

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-44 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-44 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

MARK SAGER  
PRIMARY EXAMINER

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7

20) ☐ Other:

*Specification*

1. The amendment filed Jan 14, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: 'receive prize fulfillment information used to redeem prizes won' since no redemption system is disclosed/suggested or taught. The disclosed prize lists include airline miles (which may be included in a airline's frequent flyer program); however, there is no suggestion or teaching from instant disclosure which provides support for the server to receive information 'used to redeem' prizes as in a redemption system. Essentially, there is no support for any redemption program being integral or associated with server or gaming machine or any other structure for receiving information 'used to redeem' prizes. The instant disclosure supports the server receiving information including airline miles, but does not support redemption of the accrued points [miles] since that does not form part of the original disclosed invention. Applicant is required to cancel the new matter in the reply to this Office action.

*Claim Rejections - 35 USC § 112*

2. Claim 43 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed disclosure does not support a prize server configured to receive information used to 'redeem' prizes such as in a redemption system (supra).

*Claim Rejections - 35 USC § 102*

3. Claims 1-2, 4, 6-25, 27-30 and 32-44 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kelly (6015344).

*Claim Rejections - 35 USC § 103*

4. Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (6068552) in view of Kelly (6015344). Walker discloses a gaming device and method for permitting player selection of odds, payout schedule or prize level and wager amount so the player inputs preferences which encourages them to play longer thereby generating higher revenues for the casino due to the longer play session (1:5-34, 2:1-41; 3:10-11:42, esp. 3:40-11:20, figs. 1-12) teaching claimed features/steps including memory storing a list of prizes cash, prize display mechanism displaying prizes stored in the memory, prize selection mechanism used to select prizes for game outcomes of a game played on a game machine with display wherein the prizes are cash and a server comprising an interface for providing information to gaming machines, but does not disclose 'non-cash' prizes (clms 1, 14, 21, 24, 35), 'theme' (clm 13) 'merchandise, vacations, airline miles or shopping sprees' (clms 2, 15, 23, and 37), portable memory device is a magnetic card, personal digital assistant or smart card (clms 27, 28, 40), 'printing a record' (clm 41), 'prize fulfillment information used to redeem prizes won by players playing gaming machines' (clm 43) and a 'prize fulfillment center that is used to acquire and deliver prizes' (clm 44). This lack of disclosure does not teach away from claimed invention since the standard of patentability is what the prior art taken as a whole at a time prior to the invention suggests to an artisan. In this case, regarding claims 1-2, 14-15, 21, 23-24, 35 and 37, casinos

offer or cater to player gaming preferences including prize preferences to attract them to play at their casino so as to increase their revenue thereby since the longer players continue to play the more the casinos' revenue is likely to increase (Walker, 1:5-40, 53-65). Player preferences include preferences for mode of prize being either cash or non-cash winnings since some players prefer to receive cash payout while others prefer non-cash prizes as known and as admitted prior art. Walker teaches system, method or machine to cater to player preferences including for amount of wager and size or amount of cash prize (2:1-41), but lacks disclosing non-cash prizes. Non-cash prizes, such as merchandise, vacations, airline miles or shopping sprees, are notoriously well known as 'theme' prizes having intrinsic monetary value which are monetarily equivalent to the cash prizes taught by Walker. Kelly discloses a system, machine and method for player selection of prizes from a list of prizes stored in memory either on a gaming machine with a display for displaying the list of prizes or on a server having an interface for communication with gaming machines (1:6-15, 3:29-5:45; 6:55-61:25, figs. 1-15) teaching cash (9:14-16, 10:1) and 'non-cash' prizes such as merchandise or shopping spree (9:61-10:5; 24:62-25:32; 29:40-30:18, figs. 1-15, esp. 6-6c and 9, or 32:31-46 for tournament play) including 'theme' prizes (30:8-18) which include promotional awards by voucher or certificate for shopping spree at particular sponsor (11:47-61) where non-cash prizes are monetarily equivalent to cash prizes due to their intrinsic cash value. Therefore, it would have been obvious to an artisan at time prior to invention to add 'non-cash' selected from the group of 'merchandise, vacations, airline miles, shopping sprees' and 'theme' as notoriously well known or as equivalent or as taught by Kelly to Walker's

game device and method to provide alternate equivalent payout or to motivate players to play longer by providing prizes of players' personal preference.

Further, regarding portable memory device is a magnetic card, personal digital assistant or smart card (clms 27, 28, 40), 'printing a record' (clm 41), 'prize fulfillment information used to redeem prizes won by players playing gaming machines' (clm 43) and a 'prize fulfillment center that is used to acquire and deliver prizes' (clm 44), Kelly teaches portable memory device is a magnetic card, personal digital assistant or smart card to allow transfer of stored selected prizes to be recorded onto portable magnetic media so as to allow prize claim at another or remote location by card reader (11:20-23; 15:66-16:5; 17:16-20, 39-58; 28:39-63), 'printing a record' (11:64-12:21), 'prize fulfillment information used to redeem prizes won by players playing gaming machines' (28:39-63) and a 'prize fulfillment center that is used to acquire and deliver prizes' (28:39-63) for stocking and delivering non-cash prizes. Kelly also teaches accounting or adjusting probability based in part on the intrinsic cash value of the non cash prizes (figs. 9-15). Therefore, it would have been obvious to an artisan at a time prior to the invention to add portable memory device is a magnetic card, personal digital assistant or smart card, 'printing a record', 'prize fulfillment information used to redeem prizes won by players playing gaming machines' and a 'prize fulfillment center that is used to acquire and deliver prizes' as taught by Kelly to Walker's gaming device and method to allow prize claim of player selected non-cash prize at another or remote location having a reader and to stock and deliver non-cash prizes.

Therefore, in this instance, when the prior art is taken as a whole at a time prior to the invention, Walker in view of Kelly suggests to an artisan a gaming machine, server or method, as

claimed, permitting player selection of either cash or non-cash prizes (which have an intrinsic monetary value that is monetarily equivalent to cash prizes or provided to cater to player preference) based on the players' preference so as to encourage players to continue to play longer which generates increased revenue for the casino from the longer play session.

5. Claims 3, 5, 26 and 31 are rejected as unpatentable under 35 U.S.C. 103(a) as being unpatentable over Kelly (6015344) in view Walker et al (6068552). Alternatively, Kelly discloses a system, machine and method teaching claimed invention (supra) including adjusting the probability or hit ratio based in part on the value of prize (35:31-61:25, figs. 1-15, esp. 9-9b) except 'specific to a wager amount' (clm 3), 'probability of the outcome... specific to a value of the selected prize' (clm 5), 'determining a payable... chosen according to the value of the prize selected' (clm 26) and 'specific to the wager amount' (clm 31). This lack of disclosure does not teach away from claimed invention since the standard of patentability is what the prior art taken as a whole at a time prior to the invention suggests to an artisan. In this case, Walker discloses a gaming machine, server and method (supra) teaching 'specific to a wager amount' (3:48-64, 4:49-11:42, figs. 1-12, ref. 316), 'probability of the outcome... specific to a value of the selected prize' (supra), 'determining a payable... chosen according to the value of the prize selected' (supra) and 'specific to the wager amount' (supra) to encourage players to continue playing longer by permitting players to configure game play according to their preferences including prize or wager so as to increase revenues generated thereby (1:5-41, 2:1-41). Therefore, in this instance, when the prior art is taken as a whole at a time prior to the invention, Kelly in view of Walker suggests to an artisan a gaming machine, server or method, as claimed, permitting player selection


including wager or prize of either cash or non-cash prizes (which have an intrinsic monetary value that is monetarily equivalent to cash prizes or provided to cater to player preference) based on the players' preference so as to encourage players to continue to play longer which generates increased revenue for the casino from the longer play session (Walker, 1:5-41, 2:1-41).

### *Response to Arguments*

6. Applicant's arguments with respect to claims 1-44 have been considered but are moot in view of the new ground(s) of rejection. Applicants remarks regarding Walker's teaching gaming machine with display, server with interface, memory storing list of prizes and selection of prizes for specific outcomes of a game played on a gaming machine from the stored prize list for cash or monetary values, but does not teach non-cash prizes is acknowledged (remarks pages 5-6). Applicant's admission in instant background that non-cash prizes as payout (2:22-24) such that players are motivated to play dependent on preference for cash or non-cash prizes such as cruises or automobiles (3:12-13) and in remarks (page 4) is noted. Finally, it is also noted that Kelly 6015344 incorporates 5816918 by reference at coln 1.

### *Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is (703) 308-0785. The examiner can normally be reached on T-F from 0700 to 1700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Valencia Martin Wallace, can be reached on (703) 308-4119. The fax phone number for this Group is (703) 305-3580. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.



M. Sager  
Primary Examiner  
Apr. 2, 2002